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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,517	09/23/2003	Jason P. Hill	760-28 DIV	1867
23869	7590	12/15/2004	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			MACKEY, JAMES P	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/668,517	HILL ET AL.	
	Examiner	Art Unit	
	James Mackey	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/23/03; 11/28/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Applicant should update the status of the parent application cited at the beginning of the specification, including the patent number.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, "said outer roller" (twice) lacks proper antecedent basis in the claim, and is indefinite as to exactly how this relates to the "outer surface" recited in claim 28. For purposes of examination, claim 29 will be interpreted as requiring that the outer surface is an outer roller. Claims 30-32 are rejected due to their dependence on indefinite claim 29 (note also that claim 30 recites "said inner and outer rollers").

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 28 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Taylor et al. (U.S. Patent 3,225,129; Figure 2).

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Taylor et al. clearly teach an apparatus comprising inner and outer relatively rotating rollers 15 for applying compression to a tube T supported therebetween.

6. Claim 28 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by German Patent Document 43 36 175 (Figures 1-4).

German '175 clearly teaches an apparatus comprising inner rotatable cylindrical roller 20, an outer roller 18 cooperating with the inner roller to compress material 26 therebetween, and means for relatively rotating the inner and outer rollers.

7. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Jakobsen et al. (U.S. Patent 4,530,811; Figures 1-2).

Jakobsen et al. teach an apparatus comprising inner rotatable cylindrical roller 28, an outer roller 22 cooperating with the inner roller to compress material 50 therebetween, and means for relatively rotating the inner and outer rollers (col. 7, lines 30-32).

8. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Ibar (U.S. Patent 4,919,870; Figure 10; col. 8, lines 32-41).

Ibar teaches an apparatus comprising an inner rotatable cylindrical sleeve roller 155 and an outer cylindrical sleeve (including balls 153) for compressing a tube 154 therebetween, with means for rotating the inner roller (col. 8, lines 32-41).

9. Claim 28 is rejected under 35 U.S.C. 102(e) as being anticipated by Colone et al. (U.S. Patent 6,187,054; Figure 4; col. 5, lines 11-22).

Colone et al. teach an apparatus comprising inner rotatable cylindrical roller 30, an outer surface 52 cooperating with the inner roller to compress material 50' therebetween, and means for relatively rotating the inner and outer rollers (see especially col. 5, lines 18-22).

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (U.S. Patent 3,225,129; Figure 2).

Taylor et al. disclose an apparatus substantially as claimed, comprising inner and outer relatively rotating rollers 15 for applying compression to a tube T supported therebetween, and further disclose means to maintain the apparatus assembly at an elevated temperature (such as by

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placing the assembly in a heated enclosure, col. 3, lines 6-10). Taylor et al. do not disclose means for movably positioning the inner roller with respect to the outer roller (claim 29), and do not disclose a warm water bath supporting the inner and outer rollers (claim 30). However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Taylor et al. by providing means for movably positioning the inner roller with respect to the outer roller in order to facilitate mounting of the tube within the apparatus assembly prior to compression, and also to facilitate removal of the tube after compression. It would have been further obvious and well within the level of ordinary skill in the art to have provided a warm water bath supporting the inner and outer rollers in order to facilitate the application of heat to the apparatus assembly and tube mounted therein, as explicitly desired by Taylor et al., and especially since such a warm water bath is equivalent to the heated enclosure explicitly disclosed by Taylor et al.

14. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Jakobsen et al. (U.S. Patent 4,530,811; Figures 1-2) or German Patent Document 43 36 175 (Figures 1-4).

Jakobsen et al. and German '175 each discloses an apparatus substantially as claimed, comprising inner rotatable cylindrical roller, an outer roller cooperating with the inner roller to compress material therebetween, and means for relatively rotating the inner and outer rollers. While each of Jakobsen et al. and German '175 further discloses means for movably supporting the outer roller with respect to the inner roller, neither explicitly discloses means for movably positioning the inner roller with respect to the outer roller. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify either Jakobsen et al. or German '175 by providing means for moving the inner roller with respect to the outer roller,

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since such would have been equivalent to the means for moving the outer roller with respect to the inner roller as disclosed in either Jakobsen et al. or German '175 for performing the same function of relatively moving the two rollers into compressive engagement, and especially considering that it has been held to be within the general level of skill in the art to reverse the location of parts when the operation of the device is not otherwise changed (see *In re Japikse*, 86 USPQ 70; *In re Gazda*, 104 USPQ 400), and a skilled artisan would have recognized that the apparatus would function equally well with either of the inner or outer rollers being movably positioned for relatively moving the rollers into compressive engagement.

15. Claims 31 and 32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or fairly suggest an apparatus including an inner luminal roller having an outer surface for supporting a tube thereabout, an outer roller relatively movable positioned with respect to the inner roller to place the tube wall in compression therebetween, and means for relatively rotating the inner and outer rollers, and further including at least one tensioning roller for supporting the tube thereabout, the tensioning roller being spring biased away from the inner roller for maintaining an outward radial tension on the tube, as claimed in claims 31 and 32.

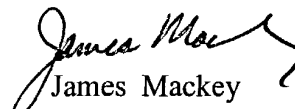
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ben Utech can be reached on 571-272-1137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James Mackey
Primary Examiner
Art Unit 1722

12/13/04

jpm
December 13, 2004